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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/922,089	08/03/2001	Denise Pelley	1948.ENV	8712

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EXAMINER

HAILEY, PATRICIA L

ART UNIT	PAPER NUMBER
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1755

DATE MAILED: 12/05/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/922,089

Applicant(s)

PELLEY ET AL.

Examiner

Patricia L. Hailey

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1755

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 01 October 2003.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-19 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-19 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. §§ 119 and 120

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 13) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application) since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.
- a) ☐ The translation of the foreign language provisional application has been received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121 since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 6.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

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Applicants' remarks and amendments, filed on October 1, 2003, have been carefully considered. In the amendments, claims 6 and 7 have been amended. No claims have been canceled; new claims 16-19 have been added.

Claims 1-19 are now pending in this application.

The objection to claim 7 stated in the previous Office Action has been withdrawn in view of Applicants' amendment to this claim.

Although new claims 16-19 have been added, the subject matter therein is comparable to that of originally filed claims 12-15. Thus, these claims will not be withdrawn from consideration as a result of an election by original presentation.

However, the cited references of record are considered to continue to read upon the originally filed claims, as well as new claims 16-19.

Maintained Rejections

The following rejections are maintained:

Claim Rejections - 35 USC § 102

1. Claims 1, 2, and 9-11 stand rejected under 35 U.S.C. 102(b) as being anticipated by Eden et al. (U. S. Patent No. 5,688,845), Applicants' submitted art.

Eden et al. teach an adhesive consisting essentially of at least about 50% to less than 100% of a maltodextrin syrup, 0 to about 50% water, and a preservative. The maltodextrin is prepared from a converted or non-converted chemically derivatized starch. See col. 4, lines 23-41 of Eden et al.

The starch can be derivatized by either heat- and/or acid conversion, oxidation, phosphorylation, etherification, esterification, etc. Further, the starch is preferably derivatized before subjected to enzyme conversion. See col. 7, lines 38-49 of Eden et al.

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The adhesive may also contain additional ingredients such as salts (to cause hygroscopic blocking) and humectants (to reduce the adhesive's initial viscosity). See col. 7, lines 5-18 of Eden et al., as well as col. 9, lines 12-20.

The property of flow viscosity is considered to be inherently read upon by the teaching of Eden et al., as this reference reads upon the claim limitations in their present form.

In view of these teachings, Eden et al. anticipate claims 1, 2, and 9-11.

2. Claims 1-7 and 10-15 stand, and new claims 16-19 are rejected under 35 U.S.C. 102(e) as being anticipated by Lydzinski et al. (U. S. Patent No. 6,280,515).

Lydzinski et al. teach a foamable adhesive comprising a polysaccharide modified with an alkyl succinic anhydride and water. See col. 2, lines 21-26 and lines 54-65 of Lydzinski et al.

Examples of the polysaccharide which can be modified include starches, either native, converted or derivatized. See col. 2, lines 27 to 62 of Lydzinski et al.

The adhesive may also contain additives such as humectants (such as calcium chloride and corn syrup) and synthetic resins. See col. 3, lines 1-20 of Lydzinski et al.

The adhesive of Lydzinski et al. is useful in applications such as paper laminating, surface coatings, and other adhesive applications. See col. 3, lines 33-39 of Lydzinski et al. This disclosure is considered to read upon the limitations of claims 12-15.

The property of flow viscosity is considered to be inherently read upon by the teaching of Lydzinski et al., as this reference reads upon the claim limitations in their present form.

In view of these teachings, Lydzinski et al. anticipate claims 1-7 and 10-19.

Claim Rejections - 35 USC § 103

3. Claims 1 and 8 are rejected under 35 U.S.C. 103(a) as being unpatentable over Eden et al. (U. S. Patent No. 5,688,845).

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Eden et al. is relied upon for its teachings in the above 102(b) rejection. While this reference teaches at col. 7, lines 38-45 that the starch is preferably chemically derivatized prior to enzyme conversion (i.e., heat- and/or acid conversion, oxidation, etc.), one of ordinary skill in the art would expect that these two steps are interchangeable, i.e., that the starch can be enzymatically converted prior to being derivatized, as Eden et al. do not require that these two steps be performed in any specific order.

Reversing the order of steps in a process does not impart patentability when no unexpected result is obtained. Ex parte Rubin (POBA 1959) 128 U.S.P.Q. 440, Cohn v. Comr. Pats. (DCDC 1966) 251 F Supp 378, 148 U.S.P.Q. 486.

Response to Arguments

In response to Applicants' arguments that none of the cited references "teaches or even suggests conversion to the degree required by Applicants", and that these references provide no motivation "to convert the starch for a time sufficient to obtain the specific flow viscosity required in the practice of applicants' invention", it is the Examiner's position that neither of these features are recited in the instant claims. The claims are merely directed to an adhesive comprising a converted starch derivative, which is expressly taught by the cited references. It is the claims that define the claimed invention, and it is claims, not specifications, that are anticipated or unpatentable. Constant v. Advanced Micro-Devices, Inc., 7 U.S.P.Q. 2d 1064.

Even though the claims recite that the converted starch derivative has a specified flow viscosity, said flow viscosity is considered inherently present in the converted starch derivatives of the prior art, because the prior art starch derivatives are the same as those recited in the instant claims. Applicants have not provided any tangible evidence that the prior art starch derivatives do not exhibit the claimed flow viscosity, or that the prior art starch derivatives are converted to "the degree required by Applicants", or have been converted "for a time sufficient to obtain the specific flow viscosity".

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It is well settled that when a claimed composition appears to be substantially the same as a composition disclosed in the prior art, the burden is properly upon the applicant to prove by way of tangible evidence that the prior art composition does not necessarily possess characteristics attributed to the CLAIMED composition. In re Spada, 911 F.2d 705, 15 USPQ2d 1655 (Fed. Circ. 1990); In re Fitzgerald, 619 F.2d 67, 205 USPQ 594 (CCPA 1980); In re Swinehart, 439 F.2d 2109, 169 USPQ 226 (CCPA 1971).

Moreover, a newly discovered property does not render a compound unobvious, if (1) the claimed compound is structurally obvious from a prior art compound, (2) the claimed compound possesses the same property for which the prior art compounds were useful, and (3) the prior art compound in fact possesses the newly discovered property of the claimed compound. Monsanto Co. v. Rohm & Haas Co. (DC ED Pa 1970) 420 F2d 950, 164 U.S.P.Q 556.

For these reasons, Applicants' arguments are not persuasive.

4. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

Conclusion

5. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.
6. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

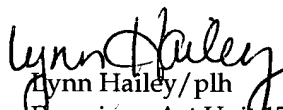
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Any inquiry concerning this communication or earlier communications from the examiner should be directed to Patricia L. Hailey whose telephone number is (703) 308-3317. The examiner can normally be reached on Mondays-Thursdays.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mark L. Bell can be reached on (703) 308-3823. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9310.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 308-0661.

After the move to the new USPTO Headquarters in Alexandria, Virginia, tentatively scheduled for the week of December 22, 2003, Examiner Hailey's new phone number will be (571) 272-1369 and Mr. Bell's new phone number will be (571) 272-1362.


Lynn Hailey/plh
Examiner, Art Unit 1755
December 2, 2003


Mark L. Bell
Supervisory Patent Examiner
Technology Center 1700